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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

James Mullin, et al.

Serial No. 09/853,427

Filed: May 10, 2001

For: EARLY DETECTION OF  
CANCEROUS AND PRECANCEROUS  
CONDITIONS BY LEAKAGE OF  
SIGNATURE PEPTIDES AND  
CARBOHYDRATES INTO THE  
BLOODSTREAM

Examiner: Susan Ungar

Group Art Unit: 1642

Response to Paper No. 8

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Certification of Mailing Under 37 CFR §1.8(a)

I hereby certify that this correspondence is being deposited on  
March 21, 2003 with the United States Postal Service as first class mail  
in an envelope addressed to COMMISSIONER OF PATENTS AND TRADEMARKS,  
Washington, D.C. 20231

March 21, 2003  
Date of Certificate

Jane C. Bogan  
Jane C. Bogan

Petition for Extension Under 37 CFR §1.136(a)

The undersigned hereby petitions for an extension of time of One (1)  
month beyond the time period set in the last office communication. The proper  
fee under 37 CFR §1.17 is enclosed.

Kathleen D. Rigaut  
Kathleen D. Rigaut, Ph.D., J.D.

Computation of Additional Fee for Extension

[ ] No Additional Fee is required.  
[ X ] A check is enclosed in the amount of \$ 55.00

\*Applicant is a Small Entity.

In the event the check is improper, or the fee calculation is in error,  
the Commissioner is authorized to charge any underpayment or credit any  
overpayment to the account of the undersigned attorneys, Account No. 04-1406.  
A duplicate copy of this sheet is enclosed.

03/31/2003 JBALINAN 00000035 09853427

01 FC:2251

55.00 OP

215 563-4100 (T)  
215 563-4044 (F)

Respectfully submitted,  
DANN, DORFMAN, HERRELL AND SKILLMAN

Kathleen D. Rigaut  
Kathleen D. Rigaut, Ph.D., J.D.  
PTO Registration No. 43,047



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of ) Examiner: Ungar, Susan  
James Mullin et al. )  
Serial No.: 09/853,427 ) Art Unit: 1642  
Filed: May 10, 2001 ) Response to Paper No. 8  
For: "EARLY DIAGNOSIS OF CANCEROUS )  
AND PRECANCEROUS CONDITIONS BY )  
LEAKAGE OF SIGNATURE PEPTIDES )  
AND CARBOHYDRATES INTO THE )  
BLOODSTREAM" )

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**TRAVERSAL AND REQUEST FOR  
RECONSIDERATION OF REQUIREMENT FOR RESTRICTION**

A revised restriction requirement under 35 U.S.C. §121 was set forth in the Official Action dated January 21, 2003 in the above-identified patent application. The Examiner has maintained that the requirement to elect a species from the group of sucrose and mannitol is proper. Applicants respectfully traverse. In fact, the two species, mannitol and sucrose, share similar structure, i.e., they are both carbohydrates, and they share similar properties, i.e., increased urine levels of which are associated with TJ leakiness in the esophageal mucosa. Moreover, the species carbohydrates are members of a Markush group. It is stated in MPEP §803.2 that:

If the numbers of Markush group are sufficiently **few in number or so closely related** that a search and examination of the entire claim can be made **without serious burden**, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions.  
(emphasis added)

In the instant case, a small number of carbohydrates (i.e., 2) are recited in the Markush group. Inasmuch as it would not pose a **serious** burden upon the Examiner to examine the signature carbohydrates, i.e., sucrose and mannitol in one group, it is improper to require Applicants to elect a single species for examination purposes.

The Examiner also asserts that claim 3 and 10 are generic to a plurality of disclosed patentably distinct species comprising methods wherein TJ leakiness is correlated with different cellular phenomena which include a) altered expression of alpha PKC, b) altered expression of ZO-1 and c) a reduced phosphorylation state of occludin. The Examiner requires an election of the species set forth in a), b) and c) above.


In light of the foregoing remarks, the restriction requirement of January 21, 2003 should be at the very least modified.

In order to be fully responsive to the above-mentioned requirement, Applicants hereby elect, with traverse, the species of sucrose and the species of a reduced phosphorylation state of occludin.

Applicants reserve the right to file one or more continuing applications, as provided in 35 U.S.C. §121, on the subject matter of any claims finally held withdrawn from consideration in this application.

Early and favorable action on the merits of this application is respectfully solicited.

Respectfully submitted,  
DANN DORFMAN HERRELL and SKILLMAN, P.C.  
Attorneys for Applicant

By   
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UNITED STATES  
PATENT AND  
TRADEMARK OFFICECommissioner for Patents  
Washington, DC 20231  
www.uspto.gov

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
09/853,427	05/10/2001	James Mullin	MUL01-NP001

CONFIRMATION NO. 6770

000110  
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Date Mailed: 03/03/2003

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 02/24/2003.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

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